

REMARKS

The following remarks and the attached Declaration in lieu of Affidavit under 37 CFR 1.132 in the name of Dr. Steve Daren address the rejections raised in the Final rejection mailed April 12, 2005. The claims in the application are now claims 1, 2, 5-7, 10-13, 19-23, 25, 26, and 28-31, and the applicants maintain that these claims meet all requirements for patentability. Accordingly, the applicants again respectfully request favorable reconsideration and allowance.

Applicants respectfully advise the PTO that the attorney docket number for this case has changed and is now "LEVI=2". Applicants request the PTO to change its records to correctly reflect the new attorney docket number.

In the Final Action, the claims were rejected under the first paragraph of Section 112. This rejection is respectfully traversed.

As regards the recitation in claim 1 of "a molecular weight which is sufficiently low so as not to cause biological degradation thereof", applicants note that this is both inherent in the examples and implicit in applicants' specification. For example, please note the observations made after 6 months in example 3 at the top of page 8 of applicants' specification, which demonstrates that biological degradation of the excrement was not prevented.

The law is clear on this issue, namely what is inherent or implicit is disclosed just as if it were explicitly disclosed. Applicants believe that it is not necessary to cite authority for the above well accepted patent law that a statement may be added to a specification or claim even though there is no explicit support in the original specification, and the added material will not be considered to be "new matter" so long as there is implicit support in the original specification. Briefly, however, the Supreme Court of the United States has so held in Marconi Wireless Telegraph Company of America v. United States, 320 US 1, 57 USPQ 471. Also see In re Wright 145 USPQ 182 and Reeves Instrument Corporation et al v. Beckman Instruments Incorporated, 161 USPQ 450,476 (Finding I2), 481 (Conclusion 25).

It has been stated that the "disclosure [in the specification] includes not only whatever is explicitly shown and described in the application, but also what is fairly to be inferred from the application taken as a whole," citing Wezel & Naumann Aktiengesellschaft v. Alexander Leunis, Inc., et al, and Morgan Lithograph Co. 6 USPQ 154, Cert. denied 285 US 545. Also see Acme Highway Products Corporation v. The D. S. Brown Company et al, 167 USPQ 129.

In the Marconi Wireless case, supra, Mr. Chief Justice Stone, speaking for the Court, stated the following [57 USPQ at 483 (Decided June 21, 1943)]:

Stone's patent, ... makes explicit, as the patent law permits, what was implicit in Stone's application. By amendments to his specifications made April 8, 1902, he recommended that the frequency impressed upon the vertical conductor at the transmitter 'may or may not be the same as the natural period or fundamental of such conductor' and that the antenna circuit at the transmitter 'may with advantage be so constructed as to be highly resonant to a particular frequency and the harmonic vibrations impressed thereon may well be of that frequency'. Since Stone used a variable inductance to alter at will the frequency of the charging circuit, this direction plainly indicated that the frequency of the antenna circuit might also be variable, and suggested the inclusion of the well-known Lodge variable inductance in the construction of the antenna circuit to achieve that result. ...

... The amendments thus merely clarified and explained in fuller detail two alternative means which could be employed in the invention described in the original application, one of those means being the construction of the antenna so as to be highly resonant, i.e., tuned, to a particular frequency.

Moreover, the burden initially is on the Examiner. Thus, it has been stated, noting *In re Edwards et al*, 196 USPQ 465,469:

The burden of showing that the ...
[subject matter in question] is not described in the application rests on the Patent and Trademark Office in the first instance, and it is up to the Patent and Trademark Office to give reasons why a description not in *Ipsis Verbis* is insufficient. *In re Salem*, ...193 USPQ 513,518...; *In re Wertheim*, ...191 USPQ at 98.
[Emphasis in original]

It is accordingly beyond question that terminology may properly be added to a specification and/or claims, if the subject matter is implicitly supported in the original disclosure, without the added language being considered prohibited "new matter".

It is quite implicit from applicants' specification that the excrement is not permanently encased by the thin film provided by applicants' composition. Thus, the molecular weight of the polymer must not be so great that it prevents biological degradation of the excrement.

With respect to claim 2, applicants believe the Examiner has misinterpreted the claim. The claim never said that applicants' composition was first formed into a film, and then the pre-formed film was applied to the excrement. Nevertheless, claim 2 has been amended to make it clear that what is claimed is the deodorizing composition which exists on the surface of the excrement in the form of a film, without there being any possibility of the claim being misconstrued to imply a pre-formed film.

With respect to claims 21 and 23 and the recitation "polymer is a low molecular weight polymer", there is nothing wrong with such language, and there is ample support in example 1 where the molecular weight was 16,000 (clearly low molecular weight). Those skilled in the art know very well what is meant by "low molecular weight".

Moreover, this is fully consistent with what applicants have pointed out above with respect to the terminal recitation in claim 1, i.e. the molecular weight must be sufficiently low so that the excrement will be permitted to degrade.

Lastly in this respect, there is nothing inconsistent with a molecular weight higher than 15,000, yet still having a "low molecular weight". Kobayashi, the relied upon prior art, discloses the use of polymers having molecular weights in the millions.

As regards claim 23, applicants do not understand the Examiner's position. The very same example that the Examiner refers to also mentions a pH of 4.6. The sentence in question (third line from the bottom on page 7), states as follows:

Addition of compositions 3.1 and 3.2
brought the pH to 4.5 and 4.6
respectively.

Applicants have a right to claim a minimum pH of 4.6 if they wish to do so. However, applicants reserve the right to change "4.6" to "4.5" if same should become necessary or desirable.

As regards claim 29, while applicants believe that the terminology "approximately 1.5%" is both understandable and within the parameters of the disclosure of the present application, the terminology in claim 29 has now been changed.

Withdrawal of the rejection is in order and is respectfully requested.

All of applicants claims have been rejected as obvious under Section 103 from Kobayashi alone, Kobayashi in view of Suzuki, and/or Kobayashi in view of Shimizu, all such rejections having been previously made. These rejections are again respectfully traversed.

All these rejections depend on the Kobayashi patent, which is critically deficient with respect to leading a person of ordinary skill in the art to or toward the present invention. Applicants respectfully repeat by reference their Remarks from the Reply filed December 29, 2004, particularly those Remarks appearing at pages 13-20.

The rejections focus on the disclosure in Kobayashi of the use of polyacrylamide (Final Action page 4, line 7). In response to applicants arguments about the critical differences in quantities, the Final Action states as follows at pages 7 and 8:

...., differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum by routine experimentation. *In re Aller*, 220 F.2d 454,456, 105 USPQ 233,235 (CCPA 1955). Applicant has not showed any criticality in the claimed concentration,....

Applicants do maintain that the quantities are critical in the sense that the very small quantities disclosed and taught by Kobayashi would not be effective to achieve the objectives of the present invention, and therefore are not simply "optimum". Indeed, applicants stated at page 15 of the Reply filed December 29, 2004, as follows, with respect to the relative quantities of polymer:

This is a crucial compositional and functional difference. The small quantity of polymer required according to Kobayashi is not sufficient to form a vapor barrier,...

Applicants stated in this regard at pages 14 and 15, encompassing the above quotation, as follows:

Perhaps most importantly, Kobayashi discloses and teaches using only a very small quantity of its high molecular weight, water soluble polymer. In this regard, the following text appears at column 9, commencing at line 49:

The concentration of the water-soluble organic polymer used in this invention is 0.05 to 50 ppm, ... most preferably 0.5 to 5 ppm,...

There is no equivocation. The maximum quantity used is 50 ppm, most preferably only 5 ppm. This makes sense in the context of Kobayashi which does not teach the formation of a film at all, but only the use of a sufficient quantity of the polymer to effect deodorizing "presumably because of the flocculating action of the polymer" (see column 9, lines 16 and 17).

The small quantity of polymer required by Kobayashi is far less than what is the minimum necessary according to the present invention. This is a crucial

compositional and functional difference. The small quantity of polymer required according to Kobayashi is not sufficient to form a vapor barrier, and indeed there is no allegation in Kobayashi of forming such a vapor barrier. As noted above, the small quantity of polymer in Kobayashi is sufficient only to provide a "flocculating" action, but is clearly not sufficient to provide a vapor barrier as claimed.

Applicants have accordingly clearly urged that the distinction over Kobayashi is critical.

The PTO is absolutely wrong in its position that the provision of a new and non-obvious result by a change in composition does not constitute patentable subject matter. Indeed, the case relied upon, *In re Aller*, 105 USPQ 233 (CCPA 1955) points out that the provision of a new result by a change in proportions does indeed constitute patentable subject matter.

Applicants now attach a Declaration in the name of Dr. Steve Daren which proves what applicants have argued, namely that the quantity of polymer taught by Kobayashi is insufficient to accomplish a stated objective of the present invention, i.e. provide a vapor barrier. Thus, the attached Declaration of Dr. Daren addresses the main point of the rejections, and shows that Kobayashi is not relevant to the present invention. Applicants respectfully request the Examiner to carefully review the attached Declaration of Dr. Daren.

As regards those rejections relying on secondary art, applicants respectfully note that Shimizu has not been cited to

make up for such deficiencies, and indeed does not do so. Accordingly, even if the proposed combination were obvious, it would not reach the claimed subject matter.

As regards Suzuki, applicants respectfully repeat by reference the arguments made from the preceding Reply. The attached Declaration of Dr. Daren establishes the un-obviousness of the present invention over the main reference relied upon, i.e. Kobayashi, and the law does not require an applicant to prove superiority over a reconstruction derived from a combination of references.

As regards claim 2, the prior art does not teach applicants deodorizing composition film form on animal excrement.

As regards claims 29 and 31, the prior art does not teach applicants composition wherein the polymer is present in an amount of at least 1.5% as called for in claim 29, or at least 2.5% as is called for in claim 31.

Applicants request withdrawal of the rejections.

Applicants believe that all issues raised in the Final Rejection have been addressed above in a manner which should lead to patentability of applicants' invention, and a granting of a patent on the claims as presently pending. Applicants accordingly respectfully request favorable reconsideration and allowance. However, if any problems remain, and if the Examiner believes that an interview would be helpful to resolve any

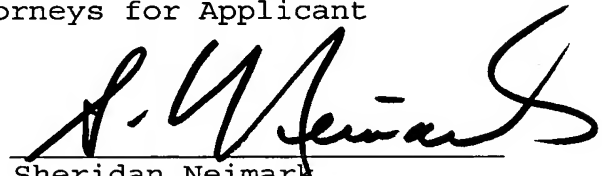
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outstanding issues, the favor of a telephone call to undersigned
would be appreciated.

Respectfully submitted,

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By

A handwritten signature in black ink, appearing to read "S. Neimark", written over a horizontal line.

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